



UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trad mark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/202,681	12/23/99	MATHUR	E 09010/044001

LISA A HAILE
FISH & RICHARDSON
4225 EXECUTIVE SQUARE
SUITE 1400
LA JOLLA CA 92037

HM12/0616

EXAMINER

STOLE, E

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

06/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/202,681

Applicant

Mathur et al.

Examiner

Einar Stole

Group Art Unit
1652



Responsive to communication(s) filed on _____

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-11 is/are allowed.

☒ Claim(s) 12 is/are rejected.

Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

DETAILED ACTION

1. Claims 1-12 are presented for examination.

Sequence Rules

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, the nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825, because a computer readable form of the "Sequence Listing" has not been filed with this application. An initial computer readable form must be submitted as required by 37 C.F.R. 1.825(d) and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

The applicant is encouraged to call (703) 308-4216 regarding any inquiry concerning rules interpretation, (703) 308-4212 for CRF submission help, and (703) 308-6856 for PatentIn software help.

Drawings

3. The drawings are objected to because of the defects noted on the enclosed Form PTO-948. Correction is required.

Art Unit: 1652

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites "administering an effective amount of an enzyme". This phrase implies *in vivo* administration to a subject/patient/animal, but, since the preamble refers only to a method of hydrolyzing phosphate bonds and the remainder of the claim is silent as to what the enzyme is administered, this phrase renders the instant claim indefinite.

Conclusion

6. Claims 1-11 are allowable over the prior art of record. A diligent search of electronic patent and scientific literature data bases revealed no prior art that either teaches or suggests: 1) polynucleotides that encode enzymes described by SEQ ID NO: 28, 29, 30, 31, 32, 33, 34, 35, or 36; 2) polynucleotides described by SEQ ID NO: 19-27, 37-41, 43, 45, 47, 49, 51, or 53; 3) vectors and transformed host cells comprising these polynucleotides; 4) the polynucleotides of ATCC Deposit No. 97379; 5) polypeptides described by SEQ ID NO: 28, 29, 30, 31, 32, 33, 34, 35, or 36; 6) polypeptides that are 70% identical to the polypeptides described by SEQ ID NO: 19-27, 37-41, 43, 45, 47, 49, 51, or 53, and 7) methods of producing these enzymes. Thus, the polynucleotides, vectors, host cells, methods and polypeptides of the instant claims are free of the prior art.

Art Unit: 1652

7. The following publication, which is made of record but not relied upon, is considered pertinent to applicant's disclosure:

(A) US PATENT 5,629,177 Hyman

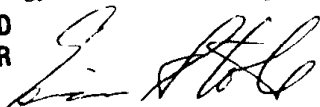
8. The Group and Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1652.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Einar Stole, Ph.D., whose telephone number is (703) -305-4507. The Examiner can normally be reached Tuesday through Friday 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ponnathatpura Achutamurthy, can be reached on (703)-308-3804. The FAX phone number for Technology Center 1600 is (703)-305-7401.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703)-308-0196.

EINAR STOLE, PH.D.
PATENT EXAMINER



June 14, 2000